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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,721	06/20/2001	John G. Babish	T9667	3304

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EXAMINER

MELLER, MICHAEL V

ART UNIT PAPER NUMBER

1651

DATE MAILED: 05/23/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/885,721

Applicant(s)

BABISH ET AL.

Examiner

Michael V. Meller

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-10,12,13,15-17 and 43-50 is/are pending in the application.
- 4a) Of the above claim(s) 43-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-10,12,13 and 15-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### *Election/Restrictions*

Applicant's election with traverse of Group I, claims 1-42 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the examiner submits no evidence showing that the different methods which can use the same composition are materially different processes and that the claims are grouped into basically two classes. This is not found persuasive because the different processes are materially distinct from one another since they do perform different functions from one another. The fact that the claims can be in two separate classes is noted, but it is also noted that the subclasses are different as well. A class has many different subclasses in it and for applicant to expect the examiner to examine every subclass within a class is an undue burden in and of itself.

Claims 43-50 are withdrawn from the examiner as being drawn to a non-elected invention.

This application contains claims 43-50 which are drawn to an invention nonelected with traverse in Paper No. 6. A complete reply to the final rejection must

include cancelation of nonelected claims or other appropriate action (37 CFR 1.144)

See MPEP § 821.01.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 6-10, 12, 13 and 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term, "consisting essentially of " is vague and indefinite. What does applicant mean by this term ? Nowhere in the specification is the term defined. In fact, Applicant even states that the alpha and beta acids are to be extracted by CO<sub>2</sub> from hops and that other ingredients are present in the composition, see page 11 of the specification, i.e. essential oils.

***Claim Rejections - 35 USC § 102***

Claims 1, 3, 4, 6 and 8 stand rejected under 35 U.S.C. 102(b) as being anticipated by Haas for the reasons of record and for the reasons which follow.

Applicant argues that hop extract resins are listed as one of antimicrobials. The group consisted of six members. Haas makes it clear that one of them can be selected. In a 35 USC 102 rejection, the patent only needs to mention the component claimed. The fact that it is in a list of six members is immaterial as long as the list includes the composition claimed. The claims are directed to a composition not a method of using the composition. The composition is the composition.

Applicant next argues that hop extracts are mixtures of many ingredients in addition to alpha acids and beta acids and then provides absolutely no evidence for this allegation. On pages 5-6 of the specification, applicant makes it clear that organic solvent extracts would contain resins. In fact, applicants disclose that they can extract with either organic solvents or CO<sub>2</sub>. Thus, applicants' extracts would read on containing resins as does Haas. Haas is clear that the extract contains lupulone and humulone.

Applicant also argues that the compositions "consist essentially of alpha acids and beta acids". Applicant has provided no evidence for this allegation either. There is no teaching in Haas that would include anything other than lupulone and humulone in the composition that would change the fundamental characteristics of the composition. The sweeteners mentioned may be in the composition but do not have to, see Haas, col. 2, lines 21-28.

Applicants also argue that Haas does not teach that the composition contains the alpha and beta acids in a ratio capable of specifically inhibiting COX-2 activity. The composition of Haas and that claimed are the same, the ratio is thus inherent because

this extract (of Haas) would also be capable of specifically inhibiting COX-2 activity as well.

***Claim Rejections - 35 USC § 103***

Claims 1-4, 6-10, 12, 13, and 15-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Haas taken with Versluys and Todd, Jr. for the reasons of record and for the reasons which follow.

Applicants arguments have been noted but are not deemed to be persuasive. The above arguments are also noted here. The addition of vitamin C would be to the composition of claim 1 which does not have to be a CO<sub>2</sub> extract. Even so, Versluys makes it clear that hops do oxidize and make it clear that one of ordinary skill in the art would be motivated to add vitamin C to the hops in an effort to prevent their oxidation. Further, Todd makes it clear that CO<sub>2</sub> extraction is well known to one of ordinary skill in the art as being commonly used to extract hops. In fact, Todd also makes it plainly clear that CO<sub>2</sub> extraction is preferred over solvent extraction, col. 2, lines 25-40.

Thus, there was clear motivation to practice the claimed method in view of the above references.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicant's PTO-1449 was not considered since it was sent out after the first office action. Thus, applicant's need to provide a certification under 37 CFR 1.97 (e) or provide the appropriate fee.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V. Meller whose telephone number is 703-308-4230. The examiner can normally be reached on Monday thru Friday: 9:00am-5:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 703-308-4743. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0294 for regular communications and 703-308-0294 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

MVM  
May 16, 2002

  
DAVID M. NAFF  
PRIMARY EXAMINER  
ART UNIT 1651